REMARKS

Claims 1-3, 5-8 and 11-22 are pending. Claims 17 and 18 are allowed. Claims 1-3, 5-8, 11-16 and 19-22 stand rejected. Applicants respectfully request reconsideration of the rejection based on the following comments.

Claim Rejections under 35 U.S.C. § 102 and/or § 103

The Examiner rejected claims 1-3, 5-10 and 19-22 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over U.S. Patent 5,389,194 to Rostoker et al. (the Rostoker patent).

The present case is on remand from the U.S. Court of Appeals for the Federal Circuit. The court mandated the consideration of the Declarations of both Dr. Singh and Dr. Kambe. Specifically, in a broad sense, two issues were argued before the court. One issue was the futile attempt to understand the teachings of the Rostoker patent, which Applicants still maintain does not disclose their claimed invention. The second issue was Applicants' well supported assertion that the Rostoker patent does not enable the practice of Applicants' claimed invention. Applicants maintain that the Examiner has fallen short of establishing *prima facie* anticipation or obviousness and to the extent that *prima facie* anticipation or obviousness has been established, these have been clearly rebutted by Applicants. Applicants respectfully request reconsideration of the rejection based on the following comments.

Applicant incorporates by reference their comments from the Supplemental Response of December 21, 2006 and the Preliminary Amendment of November 27, 2006. Applicant comments further here on the Examiner's specific comments.

As stated on page 7 of the Office Action, what the Office presents as evidence is the Rostoker patent. Applicant keeps piling on evidence that the Rostoker patent does not anticipate Applicant's claimed invention. Then, we go back to Rostoker.

As stated by the **Federal Circuit** at page 12 of their opinion that remanded the present case back to the PTO (emphasis added), "The PTO argues that as long as Rostoker enables the Rostoker invention, Rostoker renders the Kumar invention obvious, even if Kumar shows that Rostoker does not enable the Kumar invention. **That is incorrect.** To render a later invention unpatentable for obviousness, the prior art must enable a person of ordinary skill in the field to make and use the later invention. Beckman Instruments, Inc., 892 F.2d at 1551; Payne, 606 F.2d at 314. Thus the relevant inquiry is not whether the Rostoker patent was invalid for lack of enablement, but **whether Rostoker enabled persons skilled in the art to produce particles of the size and distribution claimed by Kumar.**" The court further indicated that Dr. Kambe's Declaration **needed** to be reevaluated in view of Professor Singh's Declaration. The Federal Circuit's mandates are controlling law of this case.

While the Federal Circuit stated explicitly that the Examiner's legal position regarding Rostoker is "incorrect," the Examiner is unable to take this into account in any way. With all due respect, this goes to the surprising extreme of the Examiner suggesting a reexamination of Rostoker on page 10 of the Office Action even though a reexamination cannot address any issues relevant to the present rejection. Since the Examiner is unable to apply the legal standards mandated by the Federal Circuit, it is not clear what further arguments are appropriate. The issue is not and never was whether or not the invention of Rostoker is operable. With all due respect, since the Examiner does not seem to grasp this issue, there seems to be no point in presenting legal arguments since we are not using the same legal standard of analysis.

In summary, Applicant has shown un-refuted evidence that the Rostoker patent does not teach a process suitable for producing the claimed particle collections. In addition, two declarations by experts, Dr. Kambe and Dr. Li, indicate that they know of no other approaches to produce the claimed particle distributions for these materials. The Rostoker patent does not teach any other approach for producing the particles.

In summary, the Examiner has not established *prima facie* anticipation or obviousness and to the extent that *prima facie* anticipation or obviousness has been established, this has been clearly refuted by Applicants. Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-3, 5-10 and 19-22 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over the Rostoker patent.

Claim Rejection under 35 U.S.C. § 103

The Examiner rejected claims 11-16 under 35 U.S.C. § 103(a) as being obvious over the Rostoker patent in view of U.S. Patent 6,001,730 to Farkas, et al. (the Farkas patent). The Examiner cited the Farkas patent for its teaching of liquids for forming polishing compositions. Claims 11-16 depend from claim 1. The shortcomings of the Rostoker patent with respect to teaching the features of Applicants' claim 1 were discussed in detail above. The Farkas patent does not teach or suggest aluminum oxide nanoparticles for polishing. Thus, the Farkas patent does not make up for the deficiencies of the Rostoker patent with respect to Applicants' claimed particle collections. Since the combined teachings of the Rostoker patent and the Farkas patent do not render Applicants' claimed invention *prima facie* obvious, Applicants respectfully request withdrawal of the rejection of claims 11-16 under 35 U.S.C. § 103(a) as being obvious over the Rostoker patent in view of the Farkas patent. While Applicants do not acquiesce in the Examiner's assertions regarding the features of the dependent claims, Applicants do not comment further on these issues presently since they are moot in view of the above discussion.

Rejection under Obviousness-Type Double Patenting - 09/969,025

The Examiner provisionally rejected claims 1-3, 5-8 and 19-22 under nonstatutory obviousness-type double patenting as being unpatentable over all the claims of copending Application No. 09/969,025 (the '025 application). Applicants note that the '025 application has

a priority date of October 1, 2001 and is unrelated to the present application under 35 U.S.C. 120. The present application has a filing date of August 19, 1998. Rejections for obviousness-type double patenting are not proper for applications filed after June 8, 1995 over later filed applications. See MPEP 804.02 VI.

The Examiner maintained this rejection over the above arguments. Since an earlier filed patent application cannot be a way to extend the patent term of a later filed application, the earlier filed application should not be subjected to an obviousness-type double patenting rejection. Under the Examiner's theory, most patents would be unenforceable since companies do not go back and file terminal disclaimers for all of their old patents when they file later improvement applications. Under the Examiner's theory, most older patents would be invalid whenever their was a later filed improvement patent application by the same company, which is very often the case. Thus, this is not a viable legal theory and was never the intent of the judicial doctrine.

Since this rejection is not appropriate, Applicants respectfully request withdrawal of the rejection of claims 1-3, 5-8 and 19-22 under nonstatutory obviousness-type double patenting as being unpatentable over all the claims of the '025 application.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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